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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/715,255	11/17/2003	Tsz Simon Cheng	BOC9-2003-0015 (385)	4980
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Novak Druce + Quigg LLP CityPlace Tower, 525 Okeechobee Blvd. Fifteenth-Floor WEST PALM BEACH, FL 33401			EXAMINER ZURITA, JAMES II	
			ART UNIT 3625	PAPER NUMBER
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/715,255

Applicant(s)

CHENG ET AL.

Examiner

JAMES ZURITA

Art Unit

3625

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 30 January 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 23-38 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 23-38 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/CDC)
- 4) ☐ Interview Summary (PTO-413)
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____
- Paper No(s)/Mail Date _____

DETAILED ACTION

Election/Restrictions

Applicant's election without traverse of claims 23-33 in the reply filed on 01/30/2009 is acknowledged. Applicant added claims 34-38.

Claims 23-38 are pending and will be examined.

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 23-27 and 33-38 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

As to method claims 23-27, based on Supreme Court precedence see *Diamond v Diehr* 450 US 175,184 (1981); *Parker v. Flook*, 437 US 584,588,n. 9 (1978); *Gottschalk v Benson*, 409 US 63, 70 (1972); *Cochrane v Deener*, 94 US 780, 787-88 (1876) a 101 process must (1) be tied to another statutory class (such as an apparatus) or transform underlying subject matter (such as an article or materials) to a different state or thing. Since neither of these requirements is met by the claim the claim is rejected as being directed to non-statutory subject matter.

Claims 33-38, directed to an apparatus, lack any structure and are directed to software per se.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 33-38 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 23, 28 and 33 "...initializing an electronic commerce transaction..." that is not further mentioned. The claims also refer to an "...electronic commerce action..." For purposes of examination, the term is interpreted to include customization of choice of services based upon the type of transaction.

Claims 23, 28 and 33 refer to "...actions of said adaptive document are dependent upon a state of said adaptive document..." Claims 24 and 29 refer to "...an electronic document..." and it is not clear whether applicant is referring to a second document. For purposes of examination, the term is interpreted to include xyz

Claims 23, 28 and 33 refer to "...applicant independent..." algorithms which are mentioned in para 0019. For purposes of examination, the term is given its broadest reasonable interpretation to include business rules.

In claims 33-38, the phrase "means for" appear to be an attempt to invoke 35 U.S.C. 112, sixth paragraph, to recite claim element as a means for performing a specified function. However, since the disclosures provide insufficient structural support for the claims, it is impossible to determine the equivalents of the element, as required by 35 U.S.C. 112, sixth paragraph. See *Ex parte Klumb*, 159 USPQ 694 (Bd. App. 1967). For purposes of this examination, the claim will be interpreted to not invoke the sixth paragraph. Prior art will be interpreted to read on applicant's claimed limitations

where prior art discloses that the structure is reasonable capable of performing the recited functions.

Claims 24 and 29 refer to "...converting...data from a format of ...to a format of ... using a data adaptor..." For purposes of Examination, the limitation is given its broadest reasonable interpretation to include conversion from one format to another. Prior art is interpreted to disclose the limitation where prior art includes the use of conversion to facilitate business rules, as with XML.

Claims 25 and 30 refer to "...two locations that adheres [sic]..." and appear to refer to nodes on a network. Claims 25 and 30 refer to "...transport adaptor..." and is interpreted to include formatting data for transfer over a communication link. A messaging protocol is inherent in such communicating. Applicant does not show otherwise. Prior art is interpreted to disclose the limitation where prior art discloses communicating over a network.

Claims 26 and 31 refer to "...altering a state..." and is interpreted as allowing a system to move a document to another step in a process.

Claims 27 and 32 refer to "...conveying a document to another location..." and is interpreted to include allowing another user to access the document. Claim 27 and 32 refer to "...presenting [outputting]...within an application..." for purposes of examination, the limitation is given its broadest reasonable interpretation to include business rules concerning forward chaining techniques. Prior art is interpreted to meet the limitation where prior art discloses presenting information to end users.

Claim 38 refers to "...modeled within interfaces..." and is indefinite. For purposes of examination, the limitation is given its broadest reasonable interpretation to include common interface standards and models. Prior art is interpreted to disclose the limitation where prior art discloses models that enable common understanding of services and their interfaces.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 22-38 are rejected under 35 U.S.C. 102(e) as being anticipated by Flaxer et al. (US PG-PUB 2004/0162741).

As per claim 23, Flaxer discloses method(s) for conducting an electronic commerce transaction comprising the steps of:

initializing an electronic commerce transaction; see, for example, para 0333.

inputting commerce data into an adaptive document, wherein actions of said adaptive document are dependent upon a state of said adaptive document; see, for example, para 0091

conveying said adaptive document to a different location; see, for example, at least Fig. 9 and related text.

performing at least one electronic commerce action upon said adaptive document, wherein said electronic commerce action utilizes application independent algorithms. See, for example, references to business rules, as in para 0011.

As per claim 24, Flaxer discloses inputting commerce data into an electronic document; see, for example, para 0091; converting said data from a format of said electronic document to a format of said adaptive document using a data adaptor. See, for example, at least para 0250.

As per claim 25, Flaxer discloses establishing a communication link between two locations that adheres to a messaging protocol defined by a transport adaptor; **and** conveying said adaptive document using said communication link and said messaging protocol. See, for example, at least Figs. 18-20 and related text.

As per claim 26, Flaxer discloses altering a state of said adaptive document based upon instructions detailed within a process flow. See, for example, at least Fig. 5 and related text concerning state. See also para 0088, for example.

As per claim 27, Flaxer discloses after said performing step, conveying said adaptive document to another location; see, for example, at least para 0143

converting data within said adaptive document from a format of said adaptive document to a format of an electronic document; **and** presenting at least a portion of said electronic document containing said converted data within an application of said another location. See, for example, at least para 0293.

Claim 28 is rejected on the same grounds as claim 23.

Claim 29 is rejected on the same grounds as claim 24.

Claim 30 is rejected on the same grounds as claim 25.

Claim 31 is rejected on the same grounds as claim 26.

Claim 32 is rejected on the same grounds as claim 27.

Claim 33 is rejected on the same grounds as claim 23.

As per claim 34, Flaxer discloses that the adaptive document can be conveyed among a plurality of defined states, and wherein functionality of said adaptive document is dependant upon a state within which said adaptive document is disposed. See, for example, at least para 0088.

As per claim 35, Flaxer discloses that the adaptive document can be conveyed from one defined state to another defined state in response to an occurrence of a system event. See, for example, at least para 0093.

As per claim 36, Flaxer discloses that messaging protocols are adapted to facilitate a conveyance of the adaptive document across a network. See, for example, Figs. 18-20, which show messaging across a network, which "... facilitate a conveyance of the adaptive document across a network..."

As per claim 37, xyz discloses that data is mapped from one data structure to another data structure. See, for example, at least references to XML, as in para 0155.

As per claim 38, Flaxer discloses that interactions are modeled within interfaces associated with the electronic commerce transaction. See, for example para 0295.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

A framework-based approach to building private trading exchanges, S Kumaran, Y Huang, J -Y Chung. IBM Systems Journal. Armonk: 2002. Vol. 41, Iss. 2; pg. 253, downloaded from ProQuest Direct on the Internet on 03/24/2009, 23 pages.

WebSphere as an e-business server, D F Ferguson, R Kerth. IBM Systems Journal. Armonk: 2001. Vol. 40, Iss. 1; pg. 25, downloaded from ProQuest Direct on the Internet on 03/24/2009, 29 pgs.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to JAMES ZURITA whose telephone number is (571)272-6766. The examiner can normally be reached on 8am-5pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jeffrey A. Smith can be reached on (571)272-6763. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/James Zurita/
Primary Examiner
Art Unit 3625
24 March 2009